

REMARKS

In this Response, claims 43-51 are currently pending, of which claims 43, 50, and 51 are independent. Claim 50 has been amended. Claims 1-42 have been canceled without prejudice, of which claims 10-16, 18-35, and 39-41 were not elected in the last restriction requirement, and claims 1-9, 17, 36-38 and 42 were previously canceled. Applicant reserves the right to pursue the canceled claims in a continuation or divisional application. No new matter has been added.

I. Summary of Claim Rejections

Claim 50 is rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 43, 50, and 51 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0195729 to Kodosky et al. (hereinafter “Kodosky ‘729”).

Claims 44-49 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kodosky ‘729 in view of U.S. Patent Application Publication No. 2003/0196187 to Kodosky et al. (hereinafter “Kodosky ‘187”).

II. 35 U.S.C. § 101 rejection

The Examiner rejects claim 50 under 35 U.S.C. § 101 for being “software per se” (Office Action, page 2, § 2, ¶ 4).

Applicant has amended claim 50 to recite “a computer-readable storage medium holding computer-executable instructions,” which Applicant believes is statutory subject matter and not “software per se.”

Thus, Applicant respectfully requests the Examiner to withdraw the above 35 U.S.C. § 101 rejection of claim 50.

III. Summary of Relevant Prosecution History

Applicant respectfully notes that rejections similar to the Examiner's 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a) rejections based on Kodosky '729 and Kodosky '187 were raised in the first Office Action, dated June 8, 2004. In Applicant's October 8, 2004 response, Applicant pointed out that Kodosky '729 and Kodosky '187 are not enabling references for the claims cited in the rejections and that the cited claims from Kodosky '729 and Kodosky '187 are also not entitled to the benefit of the prior filing dates of their parent applications. Thus, Applicant argued that neither Kodosky '729 nor Kodosky '187 may be used to support a 35 U.S.C. § 102(e) or 35 U.S.C. § 103(a) rejection of the pending application.

Applicant also submitted that "there were ongoing patent litigations between the assignee of the '729 reference and the assignee of the pending application. The file history of the '729 reference shows that the '729 reference was filed with claim 36 in its original claim set that copies claim 1 of the pending application. It appears that the '729 reference was simply filed to include a copy of the claimed invention with the intention to prevent the pending application from being issued to a patent."

In the second Office Action, dated March 1, 2005, the Examiner indicated that there was allowable subject matter and rejected some claims under 35 U.S.C. § 101 and 35 U.S.C. § 112, second paragraph.

In Applicant's April 19, 2005 response, Applicant amended the claims to address the Examiner's rejections and to include the indicated allowable subject matter. However, the Examiner then issued a new Office Action based on a new reference and withdrew the indication of allowable subject matter.

In this response, as will be set forth in more detail below, Applicant respectfully submits that Kodosky '729 and Kodosky '187 are still not valid prior art references with respect to claims 43-51 in the present application.

IV. 35 U.S.C. § 102(e) rejection

The Examiner rejects claims 43, 50, and 51 as being anticipated by Kodosky '729 (Office Action, page 3, § 3, ¶ 2). Applicant respectfully traverses this rejection for at least the reasons presented below.

The Examiner alleges that Kodosky '729 "teaches identifying portions of a model as being critical to a real-time execution of the model; identifying other portions of the model as being non-critical to the real-time execution of the model; [and] generating code for real-time execution based on the critical portions of the model" in Kodosky '729's claim 36. Applicant respectfully disagrees.

35 U.S.C. § 102(e) states that "A person shall be entitled to a patent unless — ... (e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent" (emphasis added). Since Applicant's filing date is July 20, 2001, and Kodosky '729's filing date is May 9, 2003, the Examiner is alleging that Kodosky '729 is entitled to the earlier filing date of its parent applications, since it is a continuation of application No. 09/788,104, filed on February 16, 2001, which is a continuation of application No. 08/912,427, filed on August 18, 1997, which was issued as Patent No. 6,219,628. Applicant respectfully disagrees since 35 U.S.C. § 120 grants the benefit of an earlier filing date only if the application is "for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States" (emphasis added).

Applicant respectfully submits that Kodosky '729 is not entitled to an earlier filing date since the parent applications of Kodosky '729 do not satisfy 35 U.S.C. § 112, first paragraph, with respect to the elements of Kodosky '729's claim 36, as required by 35 U.S.C. § 120. For example, Kodosky '729's claim 36 recites "identifying portions of a model as being either critical to a real-time execution of the model or non-critical to a real-time execution of the model." However, the parent applications of Kodosky '729 do not discuss or suggest "identifying portions of a model as being either critical to a real-time execution of the model or non-critical to a real-time execution of the model." In fact, the terms "identify," "critical," and "non-critical" can not be found in the parent applications of Kodosky '729. Therefore,

Applicant respectfully submits that the parent applications of Kodosky '729 do not contain a written description of the invention claimed in Kodosky '729's claim 36 that uses "full, clear, concise, and exact terms" that would "enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same," as required by 35 U.S.C. § 112, first paragraph. Since the parent applications of Kodosky '729 do not satisfy 35 U.S.C. § 112, first paragraph, with respect to Kodosky '729's claim 36, Kodosky '729 is not entitled to a filing date earlier than the filing date of the present application. Applicant respectfully submits that Kodosky '729 is not properly a continuation since it includes new matter with respect to its parent.

Furthermore, Applicant respectfully submits that the Examiner has not made a prima facie case that the subject matter of Kodosky '729's claim 36 was "disclosed in the earlier-filed application in compliance with 35 U.S.C. 112, first paragraph" in order to use Kodosky '729's claim 36 as an anticipatory reference. A "prima facie case [for enablement so that the reference can be anticipatory] is made out whenever a reference is shown to contain a disclosure which is specific as to every critical element of the appealed claims." *In re Wilder*, 429 F.2d 447, 166 USPQ 545 (CCPA 1970). Applicant respectfully submits that the Examiner has not made a prima facie case that the parent applications of Kodosky '729 satisfy 35 U.S.C. § 112, first paragraph with respect to Kodosky '729's claim 36, since the Examiner merely relies on Kodosky '729's claim 36 as the basis for the rejection. The Examiner has not shown how the parent applications of Kodosky '729 are "specific as to every critical element" of the claims in the pending application. In fact, the Examiner does not discuss the disclosure of the parent applications of Kodosky '729 at all.

For at least the reasons set forth above, Applicant respectfully submits that Kodosky '729 is not a valid prior art reference under 35 U.S.C. § 102(e).

In addition, Applicant respectfully points out that Applicant's filing date is July 20, 2001. Applicant's application was published on January 23, 2003 as U.S. Patent Application Publication No. 2003/0016206. Kodosky '729, on the other hand, was not filed until May 9, 2003, more than three months after the publication of Applicant's application. Kodosky '729's claim 36 is identical to Applicant's original claim 1 that was published. As discussed earlier, the

assignee for Kodosky's application is a competitor of the assignee for the currently pending application and Applicant respectfully submits that Kodosky '729 "was simply filed to include a copy of the claimed invention with the intention to prevent the pending application from being issued to a patent."

Accordingly, Applicant respectfully requests that the above 35 U.S.C. § 102(e) rejection of claims 43, 50, and 51 be withdrawn.

V. 35 U.S.C § 103(a) rejection

The Examiner rejects claims 44-49 as being unpatentable over Kodosky '729 in view of Kodosky '187 (Office Action, page 4, § 4, ¶ 2). Claims 44-49 depend from and incorporate all of the features of claim 43.

Applicant respectfully submits that Kodosky '729 and Kodosky '187, alone or in any reasonable combination, fail to disclose or suggest at least the following features of claim 43: "identifying portions of a model as being critical to a real-time execution of the model" and "identifying other portions of the model as being non-critical to the real-time execution of the model." As discussed above with respect to claim 43, Kodosky '729 is not a valid reference since it was filed after Applicant's filing date. Kodosky '187 fails to cure the deficiencies of Kodosky '729 with respect to claim 43 since Kodosky '187 does not disclose or suggest "identifying portions of a model as being critical to a real-time execution of the model" or "identifying other portions of the model as being non-critical to the real-time execution of the model." Thus, Kodosky '729 and Kodosky '187, alone or in any reasonable combination, do not disclose or suggest each and every feature in claims 44-49.

In addition, Applicant respectfully submits that the Kodosky '187 is also an invalid prior art reference. As discussed above, Applicant's filing date is July 20, 2001 and Applicant's publication date is January 23, 2003. Kodosky '187, on the other hand, was not filed until May 16, 2003, again more than three months after the publication of Applicant's application. In addition, while Kodosky '187's claims 23, 25, and 26 refer to "designated post-processing unit sections," the parent applications of Kodosky '187 do not use the terms "designated" or "post-processing" and do not discuss or suggest the invention claimed in claims 23, 25, and 26. Thus,

Applicant respectfully submits that Kodosky '187 is not entitled to an earlier priority date for claims 23, 25, and 26 since the parent applications of Kodosky '187 do not satisfy the requirements of 35 U.S.C. § 112, first paragraph, with respect to Kodosky '187's claims 23, 25, and 26.

For at least the reasons set forth above, Applicant respectfully submits that the Examiner has not made a valid 35 U.S.C. §103(a) rejection of claims 44-49. Therefore, Applicant respectfully requests that the above 35 U.S.C. § 103(a) rejection of claims 44-49 be withdrawn.

VI. Conclusion

In view of the above amendments and arguments, Applicant believes the pending application is in condition for allowance. Should the Examiner feel that a teleconference would expedite the prosecution of this application, the Examiner is urged to contact the Applicant's attorney at (617) 227-7400.

Please charge any shortage or credit any overpayment of fees to our Deposit Account No. 12-0080, under Order No. MWS-041RCE. In the event that a petition for an extension of time is required to be submitted herewith, and the requisite petition does not accompany this response, the undersigned hereby petitions under 37 C.F.R. §1.136(a) for an extension of time for as many months as are required to render this submission timely. Any fee due is authorized to be charged to the aforementioned Deposit Account.

Dated: July 1, 2008

Respectfully submitted,

Electronic signature: /Elaine Yang/
Elaine Yang
Registration No.: 60,054
LAHIVE & COCKFIELD, LLP
One Post Office Square
Boston, Massachusetts 02109-2127
(617) 227-7400
(617) 742-4214 (Fax)
Attorney/Agent For Applicant